

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 40

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte ROBERT JAMES GERNDT
and
JOHN JOSEPH SAYOVITZ

Appeal No. 2004-0342
Application No. 09/240,524

ON BRIEF

Before FRANKFORT, STAAB, and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

REMAND TO EXAMINER

This application is being remanded to the examiner for further consideration.

BACKGROUND

The record before us in this appeal establishes the following:

1. A Notice of Appeal and fee (Paper No. 30) were timely filed on July 2, 2002.

2. A single copy of the appeal brief (Paper No. 31) was filed on August 22, 2002. The appeal brief fee required by 37 CFR § 1.192(a) did not accompany the brief.
3. An examiner's answer (Paper No. 32) was mailed on November 5, 2002.
4. A reply brief (Paper No. 33) was filed on December 26, 2002.
5. The reply brief was entered and considered by the examiner and the application forwarded to the Board of Patent Appeals and Interferences (BPAI) for decision on the appeal (Paper No. 34, mailed January 14, 2003).
6. The undocketed appeal was returned to the examiner by the BPAI since there was no indication that the appeal brief fee had been received and/or applied and that only one copy of the appeal brief had been received (Paper No. 35, mailed March 11, 2003).
7. On March 31, 2003, the examiner mailed an action entitled "Response to Non-Responsive Brief" (Paper No. 36). In this action, the examiner gave the appellants a one month time limit to pay the appeal brief fee and submit two additional copies of the appeal brief.
8. On May 1, 2003, the appellants filed three additional copies of the appeal brief and a check for \$320 to cover the appeal brief fee (Paper No. 37).
9. On July 9, 2003, the examiner noted that the response filed May 1, 2003 had corrected the non-responsiveness and that the application was being forwarded to the BPAI for decision on the appeal (Paper No. 38).

10. On January 21, 2004, the BPAI docketed the appeal (Paper No. 39).

ACTION

We remand this application to the examiner to determine if the appeal should be dismissed for failure to timely pay the appeal brief fee, and if so, to determine if this application is abandoned.

37 CFR § 1.192(a) requires that the appeal brief in triplicate and the appeal brief fee set forth in § 1.17(c) must be filed within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later. 37 CFR § 1.192(b) provides that on failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed. 37 CFR § 1.192(c) sets forth the items required in the brief. 37 CFR § 1.192(d) provides that if a brief is filed which does not comply with all the requirements of 37 CFR § 1.192(c), the appellant will be notified of the reasons for non-compliance and provided with a period of one month within which to file an amended brief.

From our reading of 37 CFR § 1.192, it appears to us that the examiner did not have the authority to give the appellants a one month time limit to pay the appeal brief

fee and submit two additional copies of the appeal brief as was done in the action entitled "Response to Non-Responsive Brief" (Paper No. 36). The authority under 37 CFR § 1.192(d) to correct a defective brief appears to apply only to the requirements of 37 CFR § 1.192(c) and not to the requirements of 37 CFR § 1.192(a). It appears to us that the examiner should have instead dismissed the appeal in accordance with 37 CFR § 1.192(b) and since there are no allowed claims in this application, it appears to us that the application should be held abandoned.¹

CONCLUSION

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

If after action by the examiner in response to this remand there still remains decision(s) of the examiner being appealed, the application should be promptly returned to the BPAI.

¹ Revival of an abandoned application is permitted by 37 CFR § 1.137.

We hereby remand this application to the examiner for action as required by this remand, and for such further action as may be appropriate.

REMANDED

Charles E. Frankfort
CHARLES E. FRANKFORT

CHARLES E. FRANKFORT
Administrative Patent Judge

Lawrence J. Stroob

LAWRENCE J. STAAB
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge

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